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09/702,062	10/30/2000	William J. Flanagan	ET00-001CIP	8312

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/702,062

Applicant(s)

FLANAGAN ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-98 is/are pending in the application.
- 4a) Of the above claim(s) 18-25, 42-49, 52-59, 71-76 and 88-97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-17, 26-41, 50, 51, 60-70, 77-87 and 98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2005 has been entered.

The claims are referred to as numbered prior to allowance and include the previous corrections under Rule 1.126. (Please note that the Examiner's own numbering was off by one number when referring to many of the claims. The claim groupings have been corrected, as indicated below.)

In response to the Restriction requirement, Applicant has elected Species I, which includes claims 2-17, 26-41, 50, 51, 60-70, 77-87, and 98 (please note that the Examiner incorrectly referenced the claim numbers in the original restriction requirement).

Claims 2-17, 26-41, 50, 51, 60-70, 77-87, and 98 are presented for examination.

Priority

2. This application was filed on October 30, 2000 as a continuation-in-part of various applications filed on November 16, 1998. It has been determined that some of

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the pending claims contain continuation-in-part subject matter (i.e., subject matter that was not disclosed in the parent applications). For example, the recited "dynamic contracts manager" (recited in claims 3 and 27) and "security extensions," such as access control lists, privilege lists, etc. (recited in claims 2-17, 26-41, 50, 51, 60-70, 77-87, and 98) are not disclosed in the parent applications. Therefore, claims 2-17, 26-41, 50, 51, 60-70, 77-87, and 98 are granted a priority date of October 30, 2000 for purposes of applying prior art.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-6, 9-14, 17, 26-30, 33-38, 41, 50, 51, 60-63, 67-70, 77, 79-82, 86, 87, and 98 are rejected under 35 U.S.C. 102(b) as being anticipated by INSS, as disclosed in the packet of information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on January 27, 2005).

INSS discloses an apparatus for providing an automated system of record for at least one negotiation, comprising:

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[Claim 2] a multivariate negotiations system executing in a processor and including storage space and negotiations software (Page 1 -- "INSS is a Web-based negotiation support system"; Pages 10-11, 15 -- A history of offers and messages may be accessed; therefore, offer and message information must be stored, esp. since it is used to generate a graph of the respective histories), such negotiations software including an automated negotiations engine for analyzing terms, the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose, and placing them into user supplied context for use by a user (Pages 2, 8-13 -- The fact that the offer history data is maintained, graphed, and used by the negotiation software to determine if an optimal agreement has been reached or suggest a Pareto-optimal agreement for both parties is indicative of the fact that INSS itself analyzes and understands the negotiation terms), the automated negotiations engine being responsive to a destination terminal for a first user communicating with the multivariate negotiations system, the destination terminal including software for sending and receiving terms along a communication path which flows through the multivariate negotiations system, the automated negotiations engine also being responsive to an initiating terminal for a second user communicating with the multivariate negotiations system, the initiating terminal including software for sending and receiving terms along a communications path which flows through the multivariate negotiations system, during iterative processing the automated negotiations engine recognizing the users at the destination terminal and the initiating terminal as negotiators and recognizing one of the users as a deciding entity (Pages 1, 6, 17 -- Registered users may participate in web-

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based negotiations using INSS. Even though each party can send various offers before receiving a response from the respective counterparty, INSS recognizes which party is officially waiting for a response, thereby recognizing a relative "deciding entity." See page 17, item 5 in particular), such automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which proposed terms are being sent as the indicated terminal, and sending terms to the indicated terminal, the automated negotiations engine indicating any changes in the terms until a set of terms is acted upon in a final manner by the deciding entity (Pages 1-2, 8-13, 16, 17 -- The storage space, analysis of terms and changes thereof, and recognition of a terminal are addressed above);

a contract authority for assigning a unique identifier to such a negotiation (Page 6 – A negotiation name is assigned);

a security function for validating that the terms stored by the automated negotiations engine for such a negotiation identified by the unique identifier have appropriate access controls and privilege safeguards (Pages 6-7 – Only specified negotiators can participate in a given negotiation);

[Claim 3] wherein the contract authority further comprises a dynamic contract manager which incorporates security extensions into terms proposed by each user (Pages 6-7 – Only specified negotiators can participate in a given negotiation);

[Claim 4] wherein the security extensions further comprise access control lists (Pages 6-7 – Only specified negotiators can participate in a given negotiation);

[Claim 5] wherein the security extensions further comprise privilege lists (Pages 6-7 – Only specified negotiators can participate in a given negotiation);

[Claim 6] wherein the security function further comprises validation functions to respond to requests for information associated with the unique identifier (Pages 6-7 – Only specified negotiators can participate in a given negotiation);

[Claim 9] wherein the contract authority enables a user to associate external data with terms stored in the automated system of record, thereby becoming a part of the automated system of record (Pages 8-11 – All data entered by negotiating parties is initially “external data” and the negotiation system places the entered data into a negotiating context).

[Claims 10-14, 17] Claims 10-14 and 17 recite limitations already addressed by the rejection of claims 2-6 and 9 above; therefore, the same rejection applies.

[Claims 26-30, 33-38, 41] Claims 26-30, 33-38, and 41 recite limitations already addressed by the rejection of claims 2-6 and 9 above; therefore, the same rejection applies.

[Claims 50, 51, 60-63, 67, 68] Claims 50, 51, 60-63, 67, and 68 recite limitations already addressed by the rejection of claims 2-6 and 9 above; therefore, the same rejection applies.

Furthermore, as per claims 60-63, 67, and 68, INSS discloses the apparatus of claim 49, wherein:

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[Claim 60] the negotiations software is physically located at a central site on a network (Pages 1, 14 -- Since INSS is Web-based and available to negotiators at remote locations, there must be software running at a central site via the Web as well as at the local workstations of each negotiator);

[Claim 61] the negotiations software is physically located at a sponsor site on a network (Pages 1, 14 -- Since INSS is Web-based and available to negotiators at remote locations, there must be software running at a central site via the Web as well as at the local workstations of each negotiator);

[Claim 62] the negotiations software is physically located at a user's site on a network (Pages 1, 14 -- Since INSS is Web-based and available to negotiators at remote locations, there must be software running at a central site via the Web as well as at the local workstations of each negotiator);

[Claim 63] the network comprises an open public network (Page 1 -- INSS is Web-based and the Internet is an open public network);

[Claim 67] the negotiations software can be used by a web browser (Page 1 -- INSS is Web-based);

[Claim 68] a user may include multimedia equipment capable of capturing additional content for inclusion in the terms (Pages 8-13 -- The negotiators can view graphs as part of the negotiation process).

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[Claims 69, 70, 77, 79-82, 86, 87] Claims 69, 70, 77, 79-82, 86, and 87 recite limitations already addressed by the rejection of claims 2-6, 9, 50, 51, 60-63, 67, and 68 above; therefore, the same rejection applies.

Furthermore, as per claims 77, 79-82, 86, and 87, INSS discloses the method of claim 68, wherein:

[Claim 77] the step of analyzing further comprises the step of enabling commercial transactions over a network (Page 8 -- The price of an aircraft and terms of a warranty are negotiated in one example);

[Claim 79] the step of establishing a communications path over a network further comprises the step of physically locating negotiations at a central site on a network (Pages 1, 14 -- The negotiations are conducted through INSS's web pages. Locating negotiators who access any site is required in order to facilitate delivery of messages to each respective party);

[Claim 80] the step of establishing a communications path over a network further comprises the step of physically locating negotiations at a sponsor site on a network (Pages 1, 14 -- The negotiations are conducted through INSS's web pages. Locating negotiators who access any site is required in order to facilitate delivery of messages to each respective party);

[Claim 81] the step of establishing a communications path over a network further comprises the step of physically locating negotiations at a user's site on a network (Pages 1, 14 -- The negotiations are conducted through INSS's web pages. Locating

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negotiators who access any site is required in order to facilitate delivery of messages to each respective party);

[Claim 82] the step of establishing a communications path over a network further comprises the step of using an open, public network (Page 1 -- INSS is Web-based and the Internet is an open public network);

[Claim 86] the step of responding further comprises the step of enabling the use of a web browser (Pages 1, 14 -- INSS is Web-based);

[Claim 87] the step of establishing a communications path further comprises the step of including multimedia equipment capable of capturing additional content for inclusion in the terms (Pages 8-13 -- The negotiators can view graphs as part of the negotiation process).

[Claim 98] Claim 98 recites limitations already addressed by the rejection of claim 2 above; therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 8, 15, 16, 31, 32, 39, 40, 64-66, 78, and 83-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over INSS, as disclosed in the packet of

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information cited by Applicant as "INSS Negotiation Protocol" (dated September 1, 1998, listed on page 3 of the IDS stamped as received on January 27, 2005), as applied to claims 2, 10, 26, 34, 50, and 69 above.

[Claim 7] As per claim 7, INSS does not expressly teach that the contract authority further comprises a number generator which generates identifiers in such a way that it insures that the identifier will not be generated again within the system of record. Instead, INSS allows the system users to create names to identify specific negotiations. However, Official Notice is taken that it is old and well-known in the art of record maintenance to prevent users from duplicating an existing file name when generating and naming a new file. This prevents an existing file from being overwritten while facilitating differentiation among all files stored by a large group of users. Since INSS identifies each negotiation by a particular name specified by a negotiator, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify INSS to include a number generator which generates identifiers in such a way that it insures that the identifier will not be generated again within the system of record in order to prevent users from duplicating an existing negotiation name when generating and naming a new negotiation. This further prevents an existing negotiation from being overwritten while facilitating differentiation among all negotiations stored by a large group of users.

[Claim 8] As per claim 8, while INSS maintains a record of all communications sent back and forth between negotiators, INSS does not expressly teach that the security function further comprises audit functions for insuring that a record of each attempted

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access to the automated system of record is stored in the automated system of record. However, Official Notice is taken that it is old and well-known in the art of secure communications to maintain a record of all users who attempt to access a file, program, record, etc. This auditing feature helps to ensure data integrity by monitoring attempted breaches of secure data storage by unauthorized users. It also helps to trace back any problems in data storage and maintenance back to authorized users as well. Since INSS attempts to maintain a secure communications environment in which access to certain negotiations data is limited to authorized users, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt INSS's security function to further include audit functions for insuring that a record of each attempted access to the automated system of record is stored in the automated system of record in order to help ensure data integrity by monitoring attempted breaches of secure data storage by unauthorized users as well as tracing back any problems in data storage and maintenance back to authorized users.

[Claims 15, 16] Claims 15 and 16 recite limitations already addressed by the rejection of claims 7 and 8 above; therefore, the same rejection applies.

[Claims 31, 32] Claims 31 and 32 recite limitations already addressed by the rejection of claims 7 and 8 above; therefore, the same rejection applies.

[Claims 39, 40] Claims 39 and 40 recite limitations already addressed by the rejection of claims 7 and 8 above; therefore, the same rejection applies.

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[Claims 64-66, 83-85] As per claims 64-66 and 83-85, INSS discloses a Web-based interface, which is understood to be an open, public network; however, INSS does not expressly teach that its negotiation process may be conducted over a private network (claims 64, 83), a virtual private network (claims 65 and 84), and a local area network internal to an entity (claims 66 and 85). However, Official Notice is taken that each of these types of networks is separately old and well-known in the art of communications. These types of networks provide varying levels of security and are typically more secure than open, public networks. INSS would be operable in any type of network; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt INSS to function in any of a private network (claims 64, 83), a virtual private network (claims 65 and 84), and a local area network internal to an entity (claims 66 and 85) in order to provide negotiating entities with desired levels of secure communications, thereby making INSS more marketable to a wider range of end-users.

[Claim 78] As per claim 78, INSS discloses a negotiation regarding the price of an aircraft and the terms of a warranty (page 8), which is an example of a commercial negotiation. INSS does not expressly teach non-commercial negotiations; however, it is capable of facilitating any type of negotiation with terms to be agreed upon. A non-commercial negotiation is merely one type of negotiation with terms to be settled and agreed to by participating parties. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to

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utilize INSS to perform non-commercial negotiations as well as commercial negotiations in order to make INSS more marketable to a wider range of end-users, including those who desire to negotiate non-commercial transactions.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

September 20, 2005